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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,313	04/25/2000	Amit D. Agarwal	249768020US1	9641

25096 7590 10/19/2004

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EXAMINER	
LANEAU, RONALD	
ART UNIT	**PAPER NUMBER**
3627	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/558,313	AGARWAL, AMIT D.	
	Examiner	Art Unit	
	Ronald Laneau	3627	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *09202004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

1. The amendment filed on 07/30/2004 has been entered. Claims 1-47 are still pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 5,960,411 (Hereafter 'Hartman') in view of Kenney. Claim 1 of Hartman claims the step of "in response to only a single action being performed, sending a request to order the item". Hartman does not teach the steps of automatically initiating the replenishment of a consumable product. Kenney teaches. a method in a data processing system for automatically initiating the replenishment of a consumable product comprising the steps of receiving an order for a customer and filling that order on a first date and estimating a target date for suggesting replenishment (col. 11, lines 12r34). The user is provided with an indication that the product should be replenished (see Figures 5 and 7 and col. 12, lines 50-54). The consumer then requests replenishment of the product by performing an interaction, and the product is ordered (Fig. 1OA). The target date is

estimated based on the first date and the average life span of the item, which in turn is determined by the length of intervals between purchases (col. 11, lines 26-34). It is inherent that Kenney employs a computer memory and a computer-readable medium containing instructions for carrying out the method.

Neither Hartman nor Kenney disclose the date on which the system provides the indication to the consumer. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an indication to the consumer on or before the target date, so the consumer will not run out of the item.

The items being sold in Hartman and Kenney are physical articles. Neither Hartman nor Kenney teach the step of selling data products or services. However, the type of item being sold does not alter how the system functions. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381 , 1385, 217 USPQ 401 , 404 (Fed. Cir. 1983)., In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill in the ad at the time the invention was made to employ the combination of Hartman and Kenney to sell any type of item or service because the type of item does not patentably distinguish the claimed invention.

Neither Hartman nor Kenney teach the step of determining a target date based on availability of an item. However, it is common in the art to only suggest the purchase of an item if that item is in stock. It therefore would have been obvious to one of ordinary skill in the ad at the time the invention was made to use the availability of the item to determine a target date so that the indication is sent only if the item is available. Neither Hartman nor Kenney teach the step of determining a target date based on the size of the item. However, it is commonly known

in the ad that the size of an item will impact the length of time it takes to consume. It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine a target date based on the size of the item, so that a more accurate date is determined.

Neither Hartman nor Kenney teach the step of determining a target date base on an expiration date. However, it is commonly known in the ad that items need to be replaced after they expire. It would have been obvious to one of ordinary skill in the ad at the time the invention was made to employ to determine a target date based on an expiration date so that a customer will replace expired items.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (US 6,026,376) in view of Amazon.com, Inc. v. BarnesAndNoble.com, Inc., 239 F.3d 1343, 57 USPQ 1747 (Fed. Cir. 2001) (Hereafter "Amazon"). Kenney discloses a method in a data processing system for automatically initiating the replenishment of a consumable product comprising the steps of receiving an order for a customer and filling that order on a first date and estimating a target date for suggesting replenishment (col. 11, lines 12-34). The user is provided with an indication that the product should be replenished (see Figures 5 and 7 and col. 12, lines 50-54). The consumer then requests replenishment of the product by performing an interaction,

and the product is ordered (Fig. 10A). The target date is estimated based on the first date and the average life span of the item, which in turn is determined by the length of intervals between purchases (col. 11, lines 26-34). It is inherent that Kenney employs a computer memory and a computer-readable medium containing instructions for carrying out the method.

Kenney does not disclose the date on which the system provides the indication to the consumer. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an indication to the consumer on or before the target date, so the consumer will not run out of the item.

The items being sold in Kenney are physical articles. However, the type of item being sold does not alter how the system functions. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983): In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill in the ad at the time the invention was made to employ the system of Kenney to sell any type of item because the type of item does not patentably distinguish the claimed invention.

Kenney does not teach the step of determining a target date based on availability of an item. However, it is common in the ad to only suggest the purchase of an item if that item is in stock. It therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to use the availability of the item to determine a target date so that the indication is sent only if the item is available.

Kenney does not teach the step of determining a target date based on the size of the item. However, it is commonly known in the art that the size of an item will impact the length of time

it takes to consume. It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine a target date based on the size of the item, so that a more accurate date is determined.

Kenney does not teach the step of determining a target date base on an expiration date. However, it is commonly known in the art that items need to be replaced after they expire. It would have been obvious to one of ordinary skill in the ad at the time the invention was made to employ to determine a target date based on an expiration date so that a customer will replace expired items.

Kenney does not teach the step of requesting replenishment of the product by performing a single action. Amazon.com discusses the Compuserve Trend System, developed in the mid-199O's (see pp. 15-17). The Compuserve Trend System required only a single action to obtain fulfillment of an order (see p. 15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Amazon.com with the invention of Kenney to allow users to order an item by performing a single action, for the convenience of the customer.

5. Claims 36-38, and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (US 6,026,376).

Kenney teaches a data processing system for automatically initiating the replenishment of a consumable product comprising: receiving an order for a customer and filling that order on a first date and estimating a target date for suggesting replenishment (col. 11, lines 12-34). The user is provided with an indication that the product should be replenished (see Figures 5 and 7

and col. 12, lines 50-54). A reorder date is estimated based on the first date and the average life span of the item, which in turn is determined by the length of intervals between purchases (col. 11, lines 26-34). It is inherent that Kenney employs a computer memory, data structures, and a computer-readable medium containing instructions for carrying out the method.

Kenney does not teach the step of storing a target date on which the replenishment of the item is to be proposed. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of storing a target date for proposing replenishment of the item to ensure that the consumer is notified when the item needs to be replenished.

6. Claims 27-35 and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney as applied to claims 36-38 and 41-44 above, and further in view of Feinleib.

Kenney teaches all of the limitations of the claims except for the step of scheduling a time for transmission of a unilateral transmission indicating that the item should be purchased. Feinleib discloses a reminder system that sends email reminders at a specified time prior to an event occurrence. It would have been obvious to one of ordinary skill in the ad at the time the invention was made to employ the reminder system of Feinleib with the invention of Kenney to send timely reminders to users via email, voice mail, or instant message, regardless of whether they are engaged in electronic shopping, to ensure that customers are aware of an upcoming event.

Claims 39 and 40 are rejected under 35 U.S.C. 1O3(a) as being unpatentable over Kenney as applied to claims 36-38, and 41-44 above, and further in view of Roden et al.

Kenney teaches all of the limitations of the claims, except for a teaching that the product is automatically ordered. Roden et al disclose a method for automatically re-ordering needed inventory (see abstract). It would have been obvious to one of ordinary skill in the ad at the time the invention was made to employ the teachings of Manchala et al with the invention of Kenney to ensure that products are ordered in a timely fashion.

Response to Arguments

Applicant's arguments about the Double Patenting Rejection are not persuasive. The rejection is proper because Hartman teaches all the claimed limitations except the steps of "automatically initiating the replenishment of a consumable product" then Kenney is used to teach the "automatically initiating the replenishment of a product" Applicant further argues that Examiner has failed to identify how Kenney either discloses or suggests providing a replenishment indication including such a user interface control as part of the replenishment indication. The Examiner's position is that the local computer (20a ... 20n) can be used by a user to request that replenishment in the form of an email message as argued. In response to applicant's arguments that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). All other applicant's arguments have been addressed in the office action and the previous response to

arguments. These arguments are deemed unpersuasive and claims 1-47 remain rejected and made final.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (703) 305-3973. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RL
Ronald Laneau
Examiner
Art Unit 3627

Yolanda Harris 10/15/04
Primary Examiner

rl